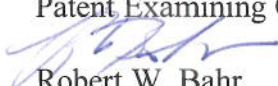




MEMORANDUM

DATE: **September 20, 2011**

TO: Patent Examining Corps

FROM:  Robert W. Bahr
Senior Patent Counsel
Acting Associate Commissioner
for Patent Examination Policy

SUBJECT: **Requirement for a Disclosure of the Best Mode**

35 U.S.C. § 112, first paragraph, provides that the specification of a patent application must include the following: (1) a written description of the invention; (2) the manner and process of making and using the invention (the enablement requirement); and (3) the best mode contemplated by the inventor of carrying out his invention. *See* MPEP 2161; *see also Ariad v. Elli Lilly*, 598 F.3d 1336, 1344 (Fed. Cir. 2010).

Section 15 of the Leahy-Smith America Invents Act does not eliminate the requirement in 35 U.S.C. § 112, first paragraph,¹ for a disclosure of the best mode, but does amend 35 U.S.C. § 282 (the provisions that sets forth defenses in a patent validity or infringement proceeding) to provide that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable. As this change is applicable only in patent validity or infringement proceedings, it does not alter current patent examining practices set forth in MPEP 2165 for evaluation of an application for compliance with the best mode requirement of 35 U.S.C. § 112.

For an invention claimed in a later-filed application to receive the benefit of the filing date of an earlier-filed application, 35 U.S.C. §§ 119(e) and 120² require that the invention claimed in the later-filed application be disclosed in the earlier-filed application in the manner provided by 35 U.S.C. § 112, first paragraph. Section 15 of the Leahy-Smith America Invents Act also amends 35 U.S.C. §§ 119(e) and 120 to modify this requirement such that the disclosure in the earlier-filed application must be made in the manner provided by 35 U.S.C. § 112, first paragraph, “other than the requirement to disclose the best mode.” This change should not noticeably impact patent examining procedure. MPEP 201.08 provides that there is no need to determine whether the earlier-filed application contains a disclosure of the invention claimed in the later-filed application in compliance with 35 U.S.C. § 112, first paragraph, unless the filing date of the earlier-filed application is actually necessary (*e.g.*, to overcome a reference). Examiners should

¹ The Leahy-Smith America Invents Act also redesignates 35 U.S.C. § 112, first through sixth paragraphs, as 35 U.S.C. § 112(a) through (f), respectively. This amendment, however, does not take effect until September 16, 2012.

² The provisions for claiming the benefit of a provisional application and a nonprovisional application, respectively.

consult with their supervisors if it appears that an earlier-filed application does not disclose the best mode for carrying out a claimed invention and the filing date of the earlier-filed application is actually necessary.

This provision took effect on September 16, 2011.